

In accordance with 37 C.F.R. § 1.121(c)(1)(ii), a marked up version of the claim amendments and a clean copy of the pending claims are attached at the end of this Amendment and Response.

### **REMARKS**

#### **Status of the Claims**

Claims 22-26, 28-30, 32-40 are pending in the Application. Claim 22 is the sole independent claim. Claims 22-24, 26, 28, 30, 32, 34-35, and 38 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,748,986 to Morrison *et al.* ("Morrison") in view of U.S. Patent No. 6,106,485 to McMahon ("McMahon") and U.S. Patent No. 5,433,907 to Slaikeu *et al.* ("Slaikeu "). Claim 29 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Morrison, McMahon and Slaikeu, further in view of U.S. Patent No. 5,947,940 to Beisel ("Beisel"). Claim 33 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Morrison, McMahon and Slaikeu, further in view of U.S. Patent No. 4,763,647 to Gambale ("Gambale"). Claim 36 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Morrison, McMahon and Slaikeu, further in view of U.S. Patent No. 5,997,517 to Whitbourne ("Whitbourne"). Finally, claims 37, 39, and 40 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Morrison, McMahon and Grenouillet, further in view of U.S. Patent No. 5,052,404 to Hodgson ("Hodgson").

Applicants respectfully traverse the outstanding rejections and respectfully request reconsideration and withdrawal of the rejection of claims 22, 25-26, 28-30, and 32-40 for the reasons discussed below.

#### **Rejections Under 35 U.S.C §103(a)**

##### **Morrison in Combination with McMahon, Slaikeu, Beisel, Gambale, Whitbourne, and/or Hodgson Fails to Teach or Suggest the Claimed Invention**

Claim 22 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Morrison in view of McMahon and Slaikeu. Morrison, in view of McMahon and Slaikeu, or any other reference of record, either alone or in proper combination, fails to teach or suggest every element recited in independent claim 22. Specifically, independent claim 22 as modified recites, in relevant part, "a

continuous, unitary coil composed of a second material and that surrounds a substantial portion of the length of the core and extends distal of the distal portion of the core" (emphasis added).

Morrison does not teach or suggest "a continuous, unitary coil ... that surrounds a substantial portion of the length of the core and extends distal of the distal portion of the core," as recited in claim 22 (emphasis added). Instead, Morrison discloses two coils, "an elongate coil 13 [that] extends substantially the entire length [of the elongate element 12] from the proximal to near the commencement of the tapered portion 12(b)," Morrison, col. 2, lines 64-67, and "[a]nother elongate coil 16 ... which adjoins the coil 13." Morrison, col. 3, lines 11-12. Thus, instead of employing the unitary coil required by claim 22, Morrison employs two coils.

McMahon fails to remedy the deficiencies of Morrison at least because McMahon also fails to teach or suggest "a continuous, unitary coil ... that surrounds a substantial portion of the length of the core and extends distal of the distal portion of the core" (emphasis added). In contrast to the claimed invention, McMahon generally is directed to "a guidewire (10) having an elongate core member (11) with a proximal core section (12), a distal core section (13), and a helical coil" See, McMahon, col. 3, lines 43-49 where "[t]he distal end of coil (14) is secured to the distal tip of the distal core" See, McMahon, col 3, lines 57-58. Thus, instead of having a coil extending distal of the distal portion of the core as required by claim 22, the coil disclosed by McMahon ends at the tip of the core.

Further, Slaikeu fails to remedy the deficiencies of Morrison and McMahon because Slaikeu fails to teach or suggest "a continuous, unitary coil ... that surrounds a substantial portion of the length of the core and extends distal of the distal portion of the core" (emphasis added). In contrast with the claimed invention, Slaikeu is directed to a medical insertion device with a "distal guide portion that is either composed of or is jacketed with a hydrophobic polymer substrate material." See, Slaikeu, col 2, lines 21-23. Specifically, Slaikeu discloses the use of a coil as a marker which is "located around the distal portion of the core wire" See, Slaikeu, col 8 lines 50-51 and Figure 3. Thus, instead of having a coil extending distal of the distal portion of the core as required by claim 22 the marker disclosed by Slaikeu ends at the distal end of the core.

Finally, Gambale, Beisel, Whitbourne, and Hodgson fail to remedy the deficiencies of Morrison, McMahon and Slaikeu because neither Gambale, Beisel, nor Whitbourne, and Hodgson teach or suggest a continuous, unitary coil composed of a second material and that

surrounds a substantial portion of the length of the core and extends distal of the distal portion of the core as recited by Applicants' claim 22.

Accordingly, the combination or modification of Morrison with McMahon and Slaikeu to produce the Applicants' claims is improper, fails to disclose every limitation of claims 22, 25-26, 28-30, and 32-40, and does not establish a *prima facie* case of obviousness against these claims. Given that these references (as well as the other references of record) each fail to teach or suggest at least one common feature recited in the independent claim 22 (i.e., a unitary coil which extends distal of the distal portion of the core), Applicants respectfully request that the Examiner reconsider and withdraw the §103 rejection of claim 22 over Morrison in view of McMahon and Slaikeu (as well as over all other references of record). Because claims 25-26, 28-30, and 32-40 depend from claim 22, and recite further limitations thereon, Applicants request that the Examiner also reconsider and withdraw the §103 rejection of these claims based on Morrison in view of McMahon and Slaikeu, as well as Gambale, Beisel, Whitbourne, or Hodgson, and other references of record.

If the Examiner maintains the rejection of claims 22, 25-26, 28-30, and 32-40, Applicants respectfully request that the Examiner point out with particularity where there is teaching in the references of the claimed structure of "a continuous, unitary coil . . . that surrounds a substantial portion of the length of the core and extends distal of the distal portion of the core," and where there exists motivation in Morrison, McMahon, or Slaikeu for combining these references, as required by MPEP §2143.03.

**CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration, withdrawal of all grounds of rejection and objection, and allowance of claims 22, 25-26, 28-30, and 32-40 in due course. If, in the Examiner's opinion, a telephonic interview would expedite the favorable prosecution of the present application, the undersigned attorney would welcome the opportunity to discuss any outstanding issues, and to work with the Examiner toward placing the application in condition for allowance.

Respectfully submitted,



John V. Bianco  
Attorney for Applicants  
TESTA, HURWITZ & THIBEAULT, LLP  
High Street Tower  
125 High Street  
Boston, MA 02110

Dated: March 31, 2003  
Reg. No. 36,748  
Tel: (617) 248-7870  
Fax: (617) 248-7100

2488850

**MARKED UP VERSION OF THE CLAIMS**

22. A guide wire comprising:

an elongate core composed of a nickel-titanium alloy including a length, a proximal portion, and a distal portion;

a continuous, unitary coil composed of a second material and that surrounds a substantial portion of the length of the core and extends distal of the distal portion of the core; and

a tip composed of a polymeric material and extending from a distal portion of the core.